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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/216,545	12/18/1998	THOMAS HAROLD ROESSLER	14.541	9533

7590

09/18/2002

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EXAMINER

REICHLE, KARIN M

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 09/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/216,545

Applicant(s)

ROESSLER ET AL.

Examiner

Karin M. Reichle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period of Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5-29-02 & 4-26-02 & 3-6-02.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-19 and 22-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-19 and 22-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 29 May 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For Example:

The prior art cited in the specification has been noted but will not appear on the front of a patent, if any, unless cited on an accompanying PTO 892 or 1449, since such citations are not in compliance with 37 CFR 1.56 and 1.97 and 1.98.

Incorporation of essential material, i.e. claimed subject matter, by reference to a foreign application or patent or to a U.S. application or patent which itself incorporates essential material by incorporation by reference is improper. Applicants should review any incorporations in this application to ensure their propriety.

The marked up copies of claim 26, section c) and the paragraph on page 23, line 15, line 1 thereof still do not comply with 37 CFR 1.121. Any further response, if any, must include compliant marked up versions of the sections discussed supra.

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 5-29-02 have been approved in part(Figure 3 only). A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

The proposed changes to Figure 4 are not approved because 76 and 78 do not accurately denote the structure described as 76 and 78 in the description.

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The drawings are objected to because in Figure 4 and the description on page 21, line 4 - page 24, last line are inconsistent, see discussion infra. In Figure 4, where is 78? 76? Correction is required.

The formal drawings filed 12-20-99 and 5-29-02 have been placed in the application file. However, approval thereof is held in abeyance until such time as all the drawing objections have been overcome.

The use of the trademarks on pages 26-27, i.e. Are Instron and Sintech trademarks?, see, e.g., page 26, lines 11-15 and 18, has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Trademarks should be shown in all capital letters or with the trademark symbol, unaccompanied by the terminology "brand" or "type" and accompanied by generic terminology.

The disclosure is objected to because of the following informalities: 1) The Summary of the Invention Section, i.e. a description of the claimed invention, and the invention as claimed are not consistent in scope, e.g., claim 26, sections b) and c). 2) In the Summary section, lines 26 and 32 thereof, "refastenably" should be --refastenable--. 3) On pages 22-25, Applicants disclose a number of methods but refer to Figure 4 which only shows one of the methods. The Figure and

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the description should consistently describe one method and indicate the other methods as not shown.

Appropriate correction is required

Claim 9 would be in better form if in section a), last line, "and" were deleted. Also in claim 27, line 2, "a fastener" would be in better form as --fasteners respectively--

Claims 9 -19, 22-25 and 30-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 9 and 15, sections b) and c), a positive structural antecedent basis for "said side edge... article "(lines 12-14 and 15-16) should be defined, i.e "attached to said side edge" should be -- respectively attached to said side edges--.

The transmittal papers indicate an assignment was supposedly filed on 12-18-98. The copy of such assignment filed 5-29-02 has been received and placed in the application file.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 9-13, 26-28 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by SCA '290.

See Figures; page 9, lines 17-20; page 5, lines 9-11, the absorbent chassis, element 13, page 7, lines 18-24, page 11, lines 11-15, the back panel; elements 5 and 8, page 5, line 19-page 6, line 10, page 7, lines 6-7, page 11, lines 11-15, front panel; element 17, page 11, lines 10-11.

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the seam. With regard to claims 26-28, such claims are product by process claims. In accord with MPEP 2113, even though the SCA product was made by a different process, since the end product is the same as the end product of claims 26-28, the claims do not distinguish over SCA.

Claims 15-19, 22-25 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCA '290 in view of McNichols '805.

The SCA device, see preceding rejection, includes all the claimed structure except for the releasable bond as set forth in subsection e) of claim 15 and the specifics thereof in the dependent claims 23-25 and 29. However, McNichols teaches a similar device which also includes a releasable bond to improve reliability of maintaining the article in a prefastened condition particularly when it is being pulled on or off the hips, i.e. to maintain the shape of and put on like a pair of ordinary underpants, see col. 15, line 9- col. 16, line 19 of McNichols. To employ a releasable bond as taught by McNichols on the SCA device would be obvious to one of ordinary skill in the art in view of the recognition that such would improve the reliability of maintaining the prefastened condition during use and the desirability of such by SCA, attention is reinvited to page 9, lines 17-20 of SCA.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over SCA '290 in view of McNichols '805 and Sauer '428.

The claim requires panels of neck-bonded laminate which SCA does not teach. SCA teaches panels of nonwoven or/and elastic material. See McNichols, col. 13, lines 15-30, and Sauer, col. 8, lines 13 et seq, which teach it is well known to form side panels of nonwoven

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or/and elastic neck-bonded laminate material. To make the side panels of neck-bonded laminate material on the SCA device would be obvious to one of ordinary skill in the art in view of the interchangeability or in view of the well known use of such material for side panels both of which are taught by McNichols and Sauer.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9-11, 14-15, 19, 22, 26-27 and 29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-16 and 21-22 of copending Application No. 09/706,294. Although the conflicting claims are not

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identical, they are not patentably distinct from each other because since the effective filing date of the instant application is before that of the '294 application but there was no administrative delay, only a one way determination, i.e. In re Vogel test, need be made, i.e. does any claim in the instant application define merely an obvious variation of an invention disclosed and claimed in the '294 application? The answer is yes because the '294 claims only further include fastener edge lengths and releaseable joint lengths in addition to the structure claimed in the instant application and it is well settled that omission of a feature, i.e. the lengths, in a combination is an obvious expedient if the remaining features perform the same function as before, In re Karlson, 136 USPQ 184 (CCPA 1963).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims -11, 14-15, 19, 22, 26-27, 29 are directed to an invention not patentably distinct from claims 14-16 and 21-22 of commonly assigned 09/706, 294. Specifically, see prior provisional rejection.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned 09/706,294, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the

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assignee is required under 37 CFR 1.78© and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Applicant's remarks have been carefully considered but are either deemed moot in that the issue has not been reraised or is deemed nonpersuasive for the reasons set forth supra.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Surprise et al patent which was one of the applications cited in an earlier IDS is made of record.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant's amendments to the claims and the newly cited but unpublished application necessitated the new grounds of rejection.

Any inquiry concerning this communication should be directed to K.M. Reichle at telephone number 703-308-2617. The Examiner's regular work schedule is Monday-Thursday.


KMR

September 8, 2002


DENNIS RUHL
PRIMARY EXAMINER